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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Language Workshop for Children/Cercle Franco  
Americain, Inc.

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Serial No. 75/516,045

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Charles H Knull of Graham, Campaign P.C. for The Language  
Workshop for Children/Cercle Franco Americain, Inc.

Toni Y. Hickey, Trademark Examining Attorney, Law Office 115  
(Tomas Vlcek, Managing Attorney).

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Before Hohein, Chapman and Rogers, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

The Language Workshop for Children/Cercle Franco  
Americain, Inc. has filed an application to register the term  
"FOR TOTS" for "educational services, namely, providing classes

in foreign languages to children and distributing course material in connection therewith."<sup>1</sup>

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's services, the term "FOR TOTS" is merely descriptive of them and that the evidentiary showing relied upon by applicant is insufficient to establish that such term has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).<sup>2</sup>

Registration also has been finally refused under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the ground that, as used in connection with the specimens furnished by applicant, the term "FOR TOTS" does not function as a service mark for applicant's services.

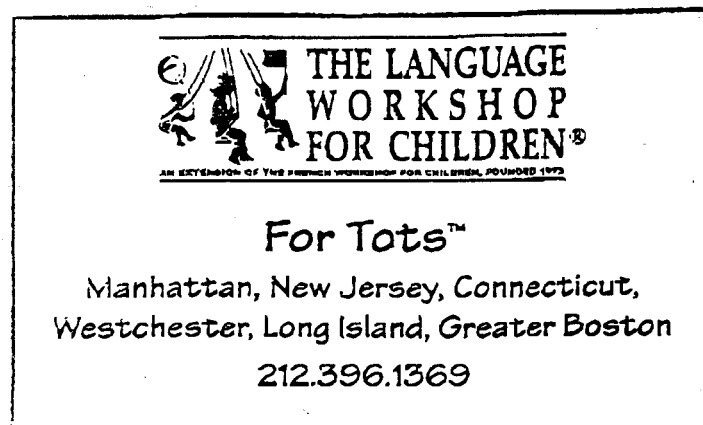
Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register as to the ground of mere descriptiveness, but reverse the refusal to register with respect to the ground of failure to function as a service mark.

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<sup>1</sup> Ser. No. 75/516,045, filed on July 9, 1998, which alleges a date of first use anywhere and in commerce of 1973.

<sup>2</sup> Thus, in the absence of a showing of acquired distinctiveness, if the term "FOR TOTS" is considered to be merely descriptive of applicant's services, it would remain unregistrable under Section 2(e)(1). See, e.g., *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), *citing* *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n. 2 (TTAB 1983).

Turning first to the latter ground of refusal, we note that applicant originally submitted various advertisements and promotional literature as specimens in which the term "FOR TOTS" appears as part of such phrases as "French for Tots," "Spanish for Tots," "Languages for Tots" and "Fun with French and Spanish for Tots." While in none of those instances is the term "FOR TOTS" used in such a manner that it makes a separate and distinct commercial impression which serves to identify and distinguish applicant's services, applicant submitted another specimen, consisting of the advertisement reproduced below,



together with a declaration from its president properly verifying that such additional specimen was in use in commerce since at least as early as the filing date of its application.

As the Examining Attorney, citing *In re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2015

(Fed. Cir. 1987), indicates in her brief, whether a term has been used as a mark for a particular service is a question of fact which is determined primarily on the basis of the specimen or specimens of use submitted with the application. In particular, she correctly observes that:

The fact that the proposed mark appears in an advertisement or brochure in which the services are advertised does not in itself show use as a mark. The record must show that there is a direct association between the mark and the service. See *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) ....

While a service mark does not have to be displayed in any particular size or degree of prominence, it must be used in a way that makes a commercial impression separate and apart from the other elements of the advertising matter or other material upon which it is used, such that the designation will be recognized by prospective purchasers as a source identifier. *In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987). Moreover, the proposed mark must not blend so well with other matter on [the] specimens that it is difficult or impossible to discern what the mark is. *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982).

Factors to be considered in determining whether the asserted mark is used as a service mark include whether the wording [claimed to constitute the mark] is physically separate from textual matter, whether [such] wording is displayed in capital letters or enclosed in quotation marks, and the manner in which a term is used in relation to other material on the specimens. See *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033 (TTAB 1981).

While a slogan can function as a ... service mark, use of a phrase or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use. See *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE [held] so highly descriptive and informational in nature that purchasers would be unlikely to perceive it as an indicator of the source of hotel services).

Although asserting in her brief, in light of the above, that "upon viewing the proposed mark on the ... specimens, the ordinary customer sees the wording FOR TOTS couched between other informational wording in such a way that it does not create a separate and distinct commercial impression apart from the other elements to constitute service mark use," the primary focus of the Examining Attorney's argument is that such wording "is used to convey to customers that the [applicant's] services are intended for use by children." Specifically, the Examining Attorney maintains that "the phrase 'FOR TOTS' is a familiar expression widely used to give customers, as the Applicant does, information about services that are offered to young children." Referring to various "Internet evidence which includes usage of the phrase 'FOR TOTS,' and evidence retrieved from Lexis/Nexis® which illustrates that the phrase 'FOR TOTS' is commonly used in connection with goods and services targeted to, and for use

by[, ] young children," the Examining Attorney contends that "[t]he widespread use of such a phrase has more than likely conditioned the public to look upon the proposed mark as merely an informational advertising slogan and not as an indicator of the source of the services."

With respect, in particular, to the additional specimen furnished by applicant and reproduced above, the Examining Attorney likewise argues that "[t]he proposed phrase FOR TOTS merely utilizes ordinary words to convey information about the Applicant's services, namely, that the services are 'for tots.'" The evidence, the Examining Attorney reiterates, clearly demonstrates that "the proposed mark is used to identify characteristics of the services and is not likely to be recognized by the public as a source indicator."

While the Examining Attorney thus concludes that "the proposed mark fails to function as a service mark," we find that, as used on the additional specimen submitted by applicant, the term "FOR TOTS" is indeed used in the manner of a service mark. Like the words and design comprising "THE LANGUAGE WORKSHOP FOR CHILDREN" mark, the term "FOR TOTS" is set off separately from the other matter in the advertisement and it is also displayed in larger type than the descriptive matter listing the locations in which applicant appears to render its services. As so used, there is a direct association between

such term and applicant's services. It plainly is used in a way that makes a commercial impression which is separate and apart from the other matter in the advertisement, such that the term "FOR TOTS" would be recognized by prospective purchasers as a source identifier. In short, unlike the other specimens submitted by applicant, the use of the term "FOR TOTS" as shown in the additional specimen filed by applicant is service mark use.

Moreover, intrinsically, the term "FOR TOTS" is clearly different from such general informational or public service advertising slogans as those at issue in, e.g., In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1460-61 (TTAB 1998) [phrase "DRIVE SAFELY" found an ordinary and commonly used safety admonition which does not function as a mark for automobiles]; In re Manco, Inc., 24 USPQ2d 1938, 1942 (TTAB 1992) [term "THINK GREEN" held an informational slogan for environmental/ecological concerns which does not function as a mark for mailing and shipping boxes and weatherstripping]; In re Remington Products Inc., 3 USPQ2d 1714, 1715 (TTAB 1987) [phrase "PROUDLY MADE IN USA" found an informational slogan which does not function as a mark for electric shavers]; In re Brock Residence Inns, Inc., supra at 922 [slogan "FOR A DAY, A WEEK, A MONTH OR MORE" held so highly descriptive and informational in nature that it would not be perceived as an indicator of source

for hotel services]; and In re Tilcon Warren, Inc., 221 USPQ 86, 88 (TTAB 1984) [phrase "WATCH THAT CHILD" is a familiar safety slogan which does not function as a mark for crushed stone and concrete]. It is apparent, therefore, that the Examining Attorney's argument that the term "FOR TOTS" fails to function as a mark is, in essence, a contention that such term is merely descriptive of applicant's services, rather than one based on the manner in which the term is used on the additional specimen.

Turning, then, to consideration of the issue of mere descriptiveness, there is no doubt that the term "FOR TOTS" is merely descriptive of applicant's educational services of providing classes in foreign languages to children and distributing course material in connection therewith. Applicant, in fact, has in effect conceded such, having amended its application to include a claim of acquired distinctiveness in response to the refusal to register on the ground of mere descriptiveness without arguing in the alternative against the refusal to register. Such a claim is tantamount to an admission that the term "FOR TOTS" is not inherently distinctive when used in connection with applicant's services and that, because it is merely descriptive thereof, it is unregistrable on the Principal Register absent a showing of acquired distinctiveness.<sup>3</sup> See,

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<sup>3</sup> This situation is to be distinguished from that where an applicant, in response to a mere descriptiveness refusal, not only adds a claim



e.g., Yamaha International Corp. v. Hoshino Gakki Co. Ltd., supra at 1005; In re Cabot Corp., 15 USPQ2d 1224, 1229 (TTAB 1990); In re Professional Learning Centers, Inc., supra at 71; and TMEP Section 1212.02(b) (3d ed. 2d rev. May 2003).

Applicant, in essence, has also conceded the mere descriptiveness of the term "FOR TOTS" inasmuch as its prior registrations on the Principal Register of the marks "SPANISH FOR TOTS" and "FRENCH FOR TOTS" for, respectively, "educational services, namely, providing classes in the Spanish language to children and distributing course material in connection therewith" and "educational services, namely, providing classes in the French language to children and distributing course material in connection therewith," each registered pursuant to the provisions of Section 2(f) with a disclaimer of the generic term "SPANISH" or "FRENCH." Because the entirety of each of such marks registered on the basis of a showing of acquired distinctiveness, it is apparent that each element of such marks, including the term "FOR TOTS," was initially considered to be

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in the alternative that the matter sought to be registered has acquired distinctiveness pursuant to Section 2(f), but also argues against the merits of the Examining Attorney's position. In such instance, it is permissible to advance the claim that such matter has acquired distinctiveness, yet argue in the alternative that the matter sought to be registered is not merely descriptive, inasmuch as the former does not constitute a concession that the matter sought to be registered is not inherently distinctive. See, e.g., In re E S Robbins Corp., 30 USPQ2d 1540, 1542 (TTAB 1992); In re Professional Learning Centers, Inc., 230 USPQ 70, 71 n. 2 (TTAB 1986); and TMEP Section 1212.02(c) (3d ed. 2d rev. May 2003).

merely descriptive of the respective services. See TMEP Sections 1212.02(e) and 1213.03(b) (3d ed. 2d rev. May 2003).

Furthermore, and aside from applicant's concessions, it is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether

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consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant, in its initial brief, "contends that FOR TOTS standing alone is a suggestive mark" because it "does not describe the attributes" of applicant's educational services of providing classes in foreign languages to children "other than the possible recipients of the services, who would not even be the decision-makers as to purchasing the services," which of course would instead be selected by the children's parents or other interested adults. While acknowledging that the record contains examples of third-party "uses of FOR TOTS in connection with other services," as well third-party registrations in which the term "TOTS" has been disclaimed, applicant points out that none of such instances pertains to language instruction programs or studies directed to children. Applicant admits, however, that as to the third-party uses of the term "FOR TOTS," such "usages are, in fact, similar to Applicant's use of FOR TOTS with descriptive words denoting language, e.g., 'shots for tots,' 'Torah for Tots' and 'Tech for Tots.'"

The Examining Attorney, on the other hand, correctly notes that a term which describes the intended users of, or targeted audience for, a particular product or service is merely descriptive thereof. See, e.g., Hunter Publishing Co. v.

Caulfield Publishing Ltd., 1 USPQ2d 1996, 1998 (TTAB 1986) [term "SYSTEMS USER" found merely descriptive of a trade journal directed toward users of large data processing systems]; In re Camel Mfg. Co., Inc., 222 USPQ 1031, 1032 (TTAB 1984) [term "MOUNTAIN CAMPER" held merely descriptive of retail mail order services in the field of outdoor equipment and apparel]; In re Gentex Corp., 151 USPQ 435, 435-36 (TTAB 1966) [term "PARADER" found merely descriptive of protective helmets for persons who parade]. She persuasively argues, in view thereof, that the record demonstrates that the term "FOR TOTS" merely describes a characteristic or feature of applicant's educational services in that such term specifies that the intended users for which it provides classes in foreign languages to children are tots.

Specifically, she points out that The American Heritage Dictionary of the English Language (3d ed. 1992) defines "tot" in relevant part as "1. A small child." In addition, she indicates in her brief that:

The examining attorney also provided evidence of the descriptive nature of the mark in the form of (1) excerpted articles from ... LEXIS/NEXIS, a computerized database in which FOR TOTS is a common phrase used to describe products and services geared toward a recognizable consumer group; (2) excerpted articles from ... the Search Engine GOOGLE, ... which demonstrate that participants in the market place need to use the term FOR TOTS to describe the target audience for their goods and services; and (3) a sample of eight

registrations wherein the term TOTS when used in connection with children related services is consistently disclaimed. The applicant's specimens include a ... mailer card, ... advertisements, and a ... brochure. All of this evidence collectively demonstrates that [applicant's] proposed mark is merely descriptive of the services because it describes the intended users of the applicant's services.

Representative examples of the above mentioned evidence include the following "LEXIS/NEXIS" excerpts (emphasis added):

"Children age 3 to 5 can enjoy a two-week camp designed just for them at Time **for Tots** ...." -- Press-Enterprise (Riverside, CA), August 14, 2002;

"Kay Vandergrift, professor of children's literature at Rutgers University, says tracts **for tots** are akin to 19th century chapbooks--'the child-sized books with good illustrations at a time when there weren't many books available to kids.'" -- USA Today, November 6, 2000;

"SCHAFFLER: Tech **for tots**. Your kids may soon throw away their blocks. Alfy.com is after your tech-savvy toddler, next." -- CNN Business Unusual, October 9, 2000;

"Water floats **for tots** are sold in toy stores because they're toys, not lifesaving devices." -- CNN News, July 27, 1997;

"Stocks **for tots**: If you want to buy a couple shares of the Boston Celtics or McDonald's for a child, Charles Schwab has made the gift a bit cheaper." -- USA Today, September 12, 1996; and

"... counties that didn't have a place for children to get their shots.

....  
'Shots **for Tots**' coordinator Donna Sacknoff says the program has helped, since 70% of the immunizations in Louisiana are done in public clinics." -- USA Today, April 19, 1994.

Articles excerpted from "GOOGLE" include the following representative examples (emphasis added):

"'Tales **for Tots**,' the free monthly ... storyhour for youngsters ages three to six, will begin its Fall Program on ... September 21, in the Children's Room." -- <http://www.hobokeni.com/fohl/tots/html>;

"'ART **FOR TOTS**' with Julie Herold  
....  
Parents! Bring your wee ones (18 months - 3 years) down and join in the fun! Julie Herold has lots of neat art activities for you and your child to share. ....  
Note: 'All Art **for Tots**' classes meet on Thursday mornings from 10:30-11:30 a.m." -- <http://www.muscatineartcenter.org/education.htm>;

"Torah **For Tots** is a wonderful enrichment program .... The classes ... provide an educational experience for three- and four-year olds, and revolve around holidays, and our wonderful Jewish culture and traditions." -- [http://uahc.org/congs/-ny/ny037/torah\\_for\\_tots.htm](http://uahc.org/congs/-ny/ny037/torah_for_tots.htm); and

"Wings **For Tots** is an innovative ... program designed for children in preschool through second grade. Each presentation uses four birds of prey, plus touchable items such as feathers, feet and wings. Through the *hands-on* experience of Wings **For Tots** children learn through teaching and tactile experience how and why a bird differs from other animals and what makes a raptor unique among birds." --

<http://www.worldbirdsanc-tuary.org/educate.html>.

The various third-party registrations, in which the word "TOTS" has been disclaimed, include such marks and associated services as "TOTALLY FOR TOTS" for "promoting shots for children"; "TERRIFIC TOTS" for "conducting parent-child interacting activity classes"; "TOTS OH MY!" for "day care services for tots and children"; "TECHNO TOTS" for "providing computer instruction to children"; "TITAN TOTS" for "child daycare centers"; and "JOLLY TOTS" and design for "specialized child care for infants age six weeks to pre-kindergarten." As to applicant's advertising and promotional materials, such specimens indicate, among other things, that its "FRENCH FOR TOTS" workshop is "[a] special playgroup that teaches toddlers to love French," while its "LANGUAGES FOR TOTS" programs, which include its "SPANISH FOR TOTS" as well as "FRENCH FOR TOTS" workshops, are touted as being "conducted by native speakers," so that "tots hear and absorb a correct form of pronunciation."

It is plain in light of the above that the term "FOR TOTS," as contended by the Examining Attorney, merely describes the intended users of or audience to whom applicant's educational services are principally directed. Nothing in such term is ambiguous or incongruous when considered in relation to applicant's educational services of providing classes in foreign

languages to children and distributing course material in connection therewith. Consequently, no imagination, cogitation or gathering of further information would be necessary in order for customers to perceive precisely the merely descriptive significance of the term "FOR TOTS." Such term immediately describes, without the need for conjecture or speculation, that a significant characteristic or feature of applicant's services is that they are intended for tots, i.e., very young children.

In addition, the fact that none of the third-party uses or registrations relates to the same services as those provided by applicant does not lessen the probative value of such evidence, since it shows, as applicant essentially admits, that regardless of the particular services in connection with which the term "FOR TOTS" is employed, it still conveys forthwith the meaning that the services are intended for tots. Several of the "GOOGLE" excerpts, in particular, illustrate such meaning with respect to various educational services consisting of classes designed for very young children. Furthermore, and in any event, even if applicant is the first and/or only user of the term "FOR TOTS" in connection with its specific educational services of providing classes in foreign languages to children and distributing course material in connection therewith, it is well established that being the initial and/or sole user of a term does not justify the registration thereof where, as here,



the term projects only a merely descriptive significance. See, e.g., In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, 507 n. 8 (CCPA 1980); and In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983).

Turning to the remaining issue in this appeal, it is settled that applicant has the burden of proof with respect to establishing a prima facie case that the term "FOR TOTS" has acquired distinctiveness. See Yamaha International Corp. v. Hoshino Gakki Co. Ltd., supra at 1006. The amount and character of evidence needed to demonstrate that a term has acquired distinctiveness, however, necessarily varies, depending upon the degree of descriptiveness involved, and becomes progressively greater as the descriptiveness of the term increases. See, e.g., In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727, 1728 n. 4 (Fed. Cir. 1990); Yamaha International Corp. v. Hoshino Gakki Co. Ltd., supra at 1008; In re Mine Safety Appliances Co., 66 USPQ2d 1694, 1697 (TTAB 2002); and In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1451 (TTAB 1994).

In this regard, Trademark Rule 2.41(a) provides in relevant part that an applicant may demonstrate that its mark has acquired distinctiveness by submitting "affidavits, or declarations in accordance with §2.20, depositions, or other evidence showing duration, extent and nature of use in commerce

and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods." In the alternative, Trademark Rule 2.41(b) provides that "[i]n appropriate cases, ownership of one or more prior registrations on the Principal Register ... of the same mark may be accepted as prima facie evidence of distinctiveness" and that an acquired distinctiveness claim may also be based on a verified statement that the mark has been in "substantially exclusive and continuous use in commerce ... by applicant for the five years before the date on which the claim of distinctiveness is made". Trademark Rule 2.41(b) additionally states that while either of such showings "may, in appropriate cases, be accepted as prima facie evidence of distinctiveness," "[i]n each of these situations, however, further evidence may be required." In addition, as set forth in TMEP Section 1212.05(a) (3d ed. 2d rev. May 2003), it is the practice of the United States Patent and Trademark Office, based upon the cases cited therein, that: "If the mark is highly descriptive or misdescriptive of the goods or services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness."

Applicant, as indicated earlier, amended its application in response to the mere descriptiveness refusal to set forth a claim of acquired distinctiveness. Initially, applicant based such claim upon an assertion of five years substantially exclusive and continuous use of the term "FOR TOTS" in commerce in connection with its services. However, because such basis was found insufficient, due to the contention that the term sought to be registered was highly descriptive of its services, applicant subsequently submitted a declaration from its president, Francois Thibaut.

In his declaration, which is dated April 13, 2000, Mr. Thibaut avers, among other things, that applicant "first made use of the service mark FOR TOTS in connection with our school in 1973; that "[s]ince that time, use of the mark has been extended not only to many other new educational programs at our school in New York City, but also to the establishment of other programs in other states"; that "[t]he mark is now used on all the programs just mentioned"; that sales of "[t]he services offered under the FOR TOTS mark during each of the past five years have amounted to" \$802,309 in 1999, \$360,183 in 1998, \$169,238 in 1997, \$109,363 in 1996 and \$108,566 in 1995; that in the same period applicant "spent the following amounts on advertising to those people (primarily parents) who purchase our services by enrolling their children in our programs": \$75,986

in 1999, \$85,000 in 1998, \$66,333 in 1997, \$33,475 in 1996 and \$35,165 in 1995; that applicant has "advertised recently" in 18 different newspapers and parenting guides published and distributed in New York City and other localities in the States of New York, New Jersey and Connecticut; that "[t]he service mark FOR TOTS is recognized in the educational sector and among parents purchasing education for their children as being a service mark of" applicant; that, as an example of such, is "an [attached] article from the Wall Street Journal [which appeared] pre-1992, concerning Spanish FOR TOTS and our other programs"; that applicant "is not aware that the service mark FOR TOTS has been used by any other school or educator to denote the providing of educational services to children"; and that applicant accordingly believes that its "use of the service mark FOR TOTS is and has been distinctive." As additional evidence offered in support of its claim of acquired distinctiveness, applicant relies upon ownership of its previously noted registrations for the marks "FRENCH FOR TOTS" and "SPANISH FOR TOTS."

Applicant insists that the above evidence suffices to demonstrate acquired distinctiveness of the term "FOR TOTS" for its educational services, asserting in its initial brief that, among other things, the Examining Attorney has not shown how "a business spending about 10% of its revenues on advertising and

marketing the services under its mark for a period of years does not meet the threshold criteria for acquired distinctiveness."

We concur with the Examining Attorney, however, that the problem with such figures, which likewise extends to evaluation of the amounts of applicant's sales, lies in the fact that, as stated in her brief, "applicant did not submit copies of the cited advertisements" and, thus, there is no way of discerning whether the term "FOR TOTS" has been used in such advertising in a manner that the purchasing public has come to recognize it as a mark. Of the sole advertising and promotional materials of record, namely, the specimens originally submitted with the application and the additional specimen subsequently filed in connection therewith, only the latter shows use, as we held above, of the term "FOR TOTS" in such a way that it functions as a mark for applicant's educational services. The extent to which applicant has used such ad, including the percentage or other indication of the amounts of its advertising and promotional expenditures spent thereon, is unknown. In view thereof, and especially in light of several instances of third-party use of the term "FOR TOTS" (e.g., "Tales for Tots," "Art for Tots," "Torah For Tots" and "Wings For Tots") in connection with educational services for tots, it is plainly the case that such term is highly descriptive of applicant's services and that sales and advertising figures, in the abstract, are insufficient

to demonstrate acquired distinctiveness. Such figures, at best, may show the popularity of applicant's services, but they do not establish recognition of the term "FOR TOTS" as a mark. See, e.g., In re Bongrain International (American) Corp., supra at 1729.

Furthermore, given the high degree of descriptiveness demonstrated by the record with respect to the term "FOR TOTS," it is clear that a claim of five years substantially exclusive and continuous use thereof in commerce is insufficient to establish acquired distinctiveness. As to applicant's additional argument, however, that its ownership of registrations on the Principal Register of the marks "FRENCH FOR TOTS" and "SPANISH FOR TOTS," for basically the same services as those set forth in this application, entitles it to a finding of acquired distinctiveness for the term "FOR TOTS," we agree with the Examining Attorney that the former are not the "same mark" as the latter for purposes of the showing permitted by Trademark Rule 2.41(b).

Applicant, as reiterated in its reply brief, argues in this regard that "[t]he difference between FOR TOTS and SPANISH FOR TOTS and FRENCH FOR TOTS is that the latter two marks add the descriptive names of languages which are the subject of the services" and which "have been disclaimed in the registrations." While conceding that "the marks are technically not the same

(being of different word count)," applicant contends that "the difference is not in the distinctive portion." Applicant's contention is misplaced since, as noted earlier, it is not the term "FOR TOTS" which was shown to have acquired distinctiveness but the entire phrases "SPANISH FOR TOTS" and "FRENCH FOR TOTS" which, with disclaimers of, respectively, the generic words "SPANISH" and "FRENCH," were found registrable pursuant to the provisions of Section 2(f) of the statute. Nevertheless, applicant further "urges the Board to adopt the view that in considering registrations for new word marks within a Family of Marks, ... the essential common element of the marks be the measure of the same mark" (underlining in original).<sup>4</sup>

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<sup>4</sup> It should be pointed out that the fact that the record shows that applicant is the owner of the two registrations mentioned above and also uses the phrase "LANGUAGES FOR TOTS" does not prove that applicant has created a "family of marks" which the purchasing public recognizes by the surname "FOR TOTS." See, e.g., J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991). As the Examining Attorney properly observes in her brief, to establish a family of marks "it must first be shown by competent evidence 'that ... the marks containing the claimed 'family feature[,] or at least a substantial number of them, were used and promoted together ... in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature; and second, that the 'family' feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as a distinguishing feature of any party's mark)," citing Land-O-Nod Co. v. Paulison, 220 USPQ 61, 65-66 (TTAB 1983). Here, even assuming that proof of a family of marks could be used to demonstrate acquired distinctiveness of the family element or surname, the Examining Attorney is correct in noting that "the words FOR TOTS are highly descriptive of the [applicant's] services[,] which ... are provided to young children, i.e., 'tots,'" and thus application of the family of marks doctrine "does not support registration of the designation FOR TOTS."

We decline applicant's invitation to adopt its viewpoint. As the Examining Attorney persuasively points out in her brief:

Applicant's prior registrations involve different marks. Even though the [marks in the] prior registrations [each] include the current proposed designation ..., the applied-for mark, FOR TOTS, does not include the word SPANISH or FRENCH. The public's association of the designations SPANISH FOR TOTS or FRENCH FOR TOTS with applicant does not mean that the mark FOR TOTS will automatically be seen by the public as also indicating source in applicant; and applicant has provided [virtually] no evidence at all as to the public perception of the applied-for mark. ....

Thus, we share the Examining Attorney's conclusion in her brief that applicant's "prior registrations do not demonstrate that the ... proposed mark has acquired distinctiveness because ... the additional terms SPANISH and FRENCH change the overall commercial impressions of the marks" so that they are not the same mark as the term "FOR TOTS." Consequently, applicant's claim under Section 2(f) falls short of the necessary showing that the term "FOR TOTS" has acquired distinctiveness with respect to its educational services and is not registrable on the Principal Register.

**Decision:** The refusal to register on the ground of failure to function as a service mark is reversed, but the refusal on the ground of mere descriptiveness, including the



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insufficiency of the evidentiary showing with respect to the claim of acquired distinctiveness, is affirmed.